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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,781	01/15/2004	Ali R. Rezai	12637/95	6304
23838 7590 02/25/2008 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
EXAMINER OROPEZA, FRANCES P				
ART UNIT		PAPER NUMBER		
3766				
MAIL DATE		DELIVERY MODE		
02/25/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,781

Applicant(s)

REZAI, ALI R.

Examiner

FRANCES P. OROPEZA

Art Unit

3766

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/28/07 (Response).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgement

1. Mr. Carl Layno was the Examiner originally assigned to this case. Mr. Layno has moved to a supervisory position in the U.S. Patent and Trademark Office. Since this case was in mid-prosecution at the time of Mr. Layno's departure, it has been assigned to a new Examiner. The current Examiner acknowledges the Applicant's response of 9/28/07. The Applicant amended the group of psychiatric disorders in the response of 9/28/07, hence this rejection is made final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 31 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner is unable to find in the instant specification the psychiatric disorder "attention deficit disorder" nor the psychiatric function "drive", these amendments made in the

response of 1/19/07. New matter may not be added at this point in the process. Appropriate correction is required.

4. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the preamble, the scope of the claim is "a psychiatric disorder or a psychiatric function", however the stimulation is delivered only to one having "a psychiatric disorder". Clarification of the scope of the claim is needed. For purposes of this examination, the scope is accepted to be a psychiatric disorder or a psychiatric function

Claim Rejections - 35 USC § 102

5. Claims 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Schiff (U.S. Patent No. 5,938,688).

Schiff discloses a method of treating a psychiatric disorder or a psychiatric function in a patient in need thereof, the method comprising:

delivering a first electrical stimulus to an intralaminar nuclei of a brain of a mammal (col. 1 @ 55-61) having a psychiatric disorder or a psychiatric function, the psychiatric disorder being attention deficit disorder (col. 5 @ 5-7; col. 11 @ Table 2), and

delivering a second electrical stimulus to another area of the brain, wherein the another area of the brain is not the intralaminar nuclei. Schiff discloses the use of two stimulations to a specific part of the intralaminar nuclei and the corresponding part of the brain having reduced base line function (col. 13 @ 42-49), the brain part accepted to be selected from the group

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consisting of the pre-frontal cortex, orbitofrontal cortex, anterior limb of the internal capsule, nucleus accumbens, ventral striatum, ventral pallidum, anterior nucleus of the thalamus, dorsomedial nucleus of the thalamus, intralaminar thalamic nuclei, cingulate cortex, amygdala, hippocampus, mammillary bodies, lateral hypothalamus, locus coeruleus, dorsal raphe nucleus, ventral tegmentum, substantia nigra pars compacta, and substantia nigra pars reticulata.

6. Claims 31 and 32 are rejected under 35 U.S.C. 102(c) as being anticipated by Stypulkowski (U.S. Patent No. 6,944,497).

Stypulkowski discloses a method of neural stimulation in sites in the brain substantially the same as the instant invention, and correlates the condition and treatment of stuttering to the condition and treatment of the "loop disorder" of obsessive-compulsive disorder, a psychiatric disorder or a psychiatric function, the method comprising:

delivering a first electrical stimulus to the medial thalamus, read as the intralaminar nuclei of a brain (abstract; col. 3 @25-52; col. 4 @ 2-6; col. 5 @ 17-20; col. 6 @ 21-23), of a mammal (figure 1) having a psychiatric disorder or a psychiatric function, the psychiatric disorder being obsessive-compulsive disorder (col. 5 @ 18), and

delivering a second electrical stimulus to another area of the brain, wherein the another area of the brain is not the intralaminar nuclei, but rather the orbital-frontal cortex (abstract; col. 3 @25-52; col. 4 @ 2-6; col. 5 @ 17-20; col. 6 @ 21-23).

Specification

7. The amendment filed 1/19/07 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the psychiatric disorder “attention deficit disorder” and the psychiatric function “drive”.

The Applicant is required to cancel the new matter in the reply to this Office Action.

Statutory Basis

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Conclusion

The Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fran Oropeza whose telephone number is (571) 272-4953. Fran's schedule typically is Monday and Tuesday 9AM-7PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl H. Layno can be reached on (571) 272-4949. Carl's schedule typically is Monday, Wednesday, Friday 9AM-5 PM EST; Tuesday, Thursday 9AM-3PM and 9PM-11PM EST. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communication and for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Frances P. Oropeza/

Patent Examiner, Art Unit 3766

/Carl H. Layno/

Supervisory Patent Examiner, Art Unit 3766